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909	7590	04/07/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			MAI, TRI M	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/687,875

Filing Date: October 20, 2003

Appellant(s): CIRONE, DOMINICK

MAILED

APR 07 2005

Group 3700

Bradford C. Blaise
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/12/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,681,821	Cirone	01/2004
4,401,245	Zills	8-1983
4,989,811	Millis et al.	2-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6681821. It would have been obvious to one of ordinary skill in the art to provide the claim 1 as a cover, without the combination with the bat, since eliminating elements is well known in the art. Furthermore, it is known in the art to provide use neoprene as the elastic rubber material to provide the desired material for the cover.
2. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6681821 in view of Jones (5417354).

Claim 1 meets all claimed limitations except for the graphic display. Jones teaches that it is known in the art to provide a graphic display (col. 8, ln. 13-17). It would have been obvious to one of ordinary skill in the art to provide a graphic display in claim 20 as taught by Jones to advertise the product.

With respect to the bat, it would have been obvious to one of ordinary skill in the art to provide the claim 1 as a cover, without the combination with the bat, since eliminating elements is well known in the art.

Claim Rejections - 35 USC § 103

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zills (4401245) in view of Millis et al. (4989811).

Zills teaches a cover having a first piece of material having first and opposing second edge fastened to form a tubular casing at portion 28 as shown in Fig. 1, and a second end closed off by a second piece at portion 16 as shown in Fig. 2. Note the edge about portion 28 is partially fastened to form a slit at portion 26, and fastening means at portion 30. Zills meets all claimed limitations except for the material being neoprene. Millis teaches that it is known in the art to make a cover from neoprene material (col. 3, lines 60). It would have been obvious to one of ordinary skill in the art to make the cover from neoprene material in Zills as taught by Millis to provide an alternative material for insulation or other properties.

With respect to the cover being used for a baseball or softball, to the degree the bat is not claimed, the cover in Zills, as modified by Millis, meets all claimed limitations. Furthermore, it is regarded as an intended use, and the claimed cover does not impart any structure over the structure in Zills.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zills in view of Millis et al., and further in view of Block (5163608) or Moseley (6065764).

The Zills combination meets all claimed limitations except for the graphic display. Either Block or Moseley teaches that it is known in the art to provide a graphic display. It would have been obvious to one of ordinary skill in the art to provide a graphic display in the modified cover of Zills as taught by either Block or Moseley to advertise the product.

(10) Response to Argument

Applicant's arguments have been fully considered but they are not persuasive.

On page 15 of the brief, applicant asserts that the examiner relies on non-analogous art.

The examiner submits that a prior art reference must either be in the field of applicant's endeavor

or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the claimed subject matter is directed to a protective cover and the prior art references relied upon are also protective covers.

“Another object of the present invention to provide combined thermally insulating and **protective jacket**” (Millis, col. 2, ln. 33-35, emphasis added).

“The jacket thus serves to both thermally insulate and **protect** the bottle” (Millis, abstract, emphasis added).

“holder which **protects** the bottle” (Millis, col. 2, ln. 33-35, emphasis added).

The examiner submits that the prior art references are pertinent to the particular problem with which the applicant was concerned, i.e., to provide cover as a protection device.

Furthermore, the examiner submits that the term “cover” explicitly implies protection. The cover is defined as “something that protects, shelters or guards”, see Merriam Webster’s Dictionary, 10th edition.

Thus, the covers as applied have protective implications as applicant’s cover.

On page 15 of the brief, applicant asserts that the examiner failed to set forth a *prima facie* case of obviousness and applicant listed the three requirements. Applicant asserts that there is no teaching of the limitations “**is adapted to** cover substantially only the barrel portion of the bat when the bat is inserted into the interior cavity such that an end of the barrel portion abuts the closed second end of the substantially tubular casing”. The examiner submits that the recitation “adapted to” is an intended use and such recitation must result in a structural difference between

the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the claimed cover does not impart any structure over the cover in Zills or Millis.

Applicant asserts that there are recitations referring to a bat. The examiner submits that the structure of the bat is recited only as an intended use.

In response to applicant's arguments, the recitation "a protective bat cover for a bat" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the preamble recited the bat structure as an intended use.

Applicant further asserts that there is no suggestion to combine. The examiner submits that Millis provide Millis teaches that it is known in the art to make a cover from neoprene material:

"Jacket 5...of a foam rubber variety having a cushioning effect, such as a neoprene covered cloth, where the cloth may be, for example, a pattern-imprinted nylon sheet". (col. 3, ln. 60-63). The examiner submits that it would have been obvious to one of ordinary skill in the art

to make the cover of Zills from neoprene to provide an alternative insulating material and or cushioning effect as set forth in the Millis reference.

With respect to the Zills, Millis, and further in view of either Block or Moseley, applicant asserts that the combination was made in hindsight. The examiner submits that the combination of Zills in view of Millis clearly suggest that a graphic can be made on the cover.

“Jacket 5...of a foam rubber variety having a cushioning effect, such as a neoprene covered cloth, where the cloth may be, for example, a **pattern-imprinted nylon sheet**”. (col. 3, ln. 60-63, emphasis added).

Either Block or Moseley teaches that it is known in the art to provide a graphic on a cover. Thus, it would have been obvious to one of ordinary skill in the art to provide the graphic in either Block or Moseley to provide advertisement. The examiner submits that to provide a graphic in covers requires only ordinary skill in the art and common sense.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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Primary Examiner
Art Unit 3727

April 4, 2005

Conferees

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